

REMARKS

The present application includes pending claims 1-48, all of which have been rejected. No claims are amended by this response. Claims 1, 15, 25, 30, and 35 are independent claims, from which claims 2-14, 16-24, 26-29, 21-34, and 36-48 depend, respectively.

Claims 1-48 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 7,065,778 ("Lu") in view of U.S. 2002/0154892 ("Hoshen"), and further in view of U.S. 2004/0125789 ("Parker").

The Applicants note that a goal of patent examination is to provide a prompt and complete examination of a patent application.

It is essential that patent applicants obtain a prompt yet complete examination of their applications. Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the initial review of the application, even if one or more claims are found to be deficient with respect to some statutory requirement. Thus, USPTO personnel should state all reasons and bases for rejecting claims in the first Office action. Deficiencies should be explained clearly, particularly when they serve as a basis for a rejection. Whenever practicable, USPTO personnel should indicate how rejections may be overcome and how problems may be resolved. **A failure to follow this approach can lead to unnecessary delays in the prosecution of the application.**

M.P.E.P. § 2106(II) (emphasis added).

As such, the Applicants assume, based on the goals of patent examination noted above, that the current Office Action sets forth "all reasons and bases" for rejecting the claims.

The Applicants respectfully traverse the rejections of the instant Office action for

at least the reasons previously discussed during prosecution and the following.

Applicants respectfully note that all pending claims are rejected for alleged reasons of obviousness. Applicants respectfully submit that the Office action has failed to establish a *prima facie* case of obviousness, in accordance with M.P.E.P. §2142.

Applicants first review requirements for a rejection based on obviousness. According to M.P.E.P. §2142, "[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness." M.P.E.P. §2142 further states that "[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious." As recognized in M.P.E.P. §2142, "[t]he Supreme Court in *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007), 82 USPQ2d 1385, 1396 noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit." In addition, the Federal Circuit has made clear that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 127 S. Ct. 1727 (2007), 82 USPQ2d at 1396.

In addition, as noted in the Manual of Patent Examining Procedure (Revision 7, July 2008), "[t]o establish *prima facie* obviousness of a claimed invention, **all the claim limitations** must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." See MPEP at 2143.03. Further, "**all words in a claim** must be considered in judging the patentability of that claim against the prior art."

In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA)." *See id.*

Thus, the law is clear that words of a claim cannot be merely disregarded during examination in an effort to assert a quick and easy rejection. Instead, **all** the words in a claim **must** be considered during the examination process.

With regard to independent claim 1, Applicants respectfully submit that claim 1 recites, *inter alia*, "second software configured to enable a user at the first home to construct, at the first home, at least one user defined media channel, the second software also configured to enable closed and secure communication of the at least one user defined media channel to others within a user defined group that are at separate and distinct locations from the first home, in a peer-to-peer manner, from the first home." Independent claims 15, 25, 30, and 35 recite similar language. The Applicants respectfully submit that the proposed combination of Lu, Hoshen, and Parker does not describe, teach, or suggest all aspects of Applicants' claims 1, 15, 25, 30, and 35.

The Office admits that Lu and Hoshen in combination do not disclose at least the above aspect of Applicants' claim 1. *See* Office action at page 5. The Office, however, then turns to Parker, and states the following:

10. In analogous teaching, Parker exemplifies this where Parker teaches wherein second software configured to enable a user at the first home to construct (a network-enabled personal computer workstation 14; Fig. 1), at the first home, at least one user defined media channel (see VT and Record Database Server 35; Fig. 1), the second software also configured to enable closed and secure communication of the at least one user defined media channel to others within a user defined group that are at separate and distinct locations from the first home, in a peer-to-peer manner, from the first home (see fig. 1 and details wherein a data network interconnects the service provider workstation and the requester communication device, and

the service provider workstation and the requester communication device have respective network addresses. A requester information database stores a data record corresponding to the requester. The requester communication device includes a signaling device for generating a request signal and a controller responsive to the request signal for initiating a video communication link between the requester communication device and the service provider workstation using the respective network addresses and for initiating display of the data record at the service provider workstation).

(emphasis added)(See Office action at pages 5-6.)

Initially, Applicants respectfully submit that the Office fails to specifically cite any text from Parker to shed light on why the Office selected the elements of Parker identified above, and merely copies the underlined portion of text that appears at the Abstract and paragraph [0009]. The Office does not explain how this portion of Parker supports the rejection by teaching Applicants' claimed subject matter, as required by M.P.E.P. §2142. In particular, the Office does not explain specifically how and why the identified elements and the underlined text from Parker teach all of the features of Applicants' claim 1. This defect of the Office action is common to the arguments presented over the features of at least claims 1, 15, 25, 30, and 35. Thus, Applicants respectfully submit that the Office has not established a *prima facie* case of obviousness at least because the Office does not show how all aspects of Applicants' claim 1 are taught by the cited art.

Applicants respectfully submit that the invention of Parker relates to "a video telephony system for conducting communications supplemented by presenting digital data records to a service provider automatically in response to a video telephony call." *Id.* at para. [0003].

Applicants respectfully submit that Parker teaches a “computer workstation 14” is used by “service provider,” described by Parker as a “medical caregiver.” *Id.* at Abstract. The “service provider” receives video telephony calls initiated from a “service requester” (a “medical patient”) at the location of a “requester communication device.” *Id.* at Abstract and ¶[0019]. Video calls to the “service provider” are initiated from the “requester communication device” manually (e.g. by push button) or automatically (e.g., caused by telephone call to particular number or by “patient monitor 33”). *Id.* at paras. [0020], [0023], [0024]. A “data record” stored in a “requester information database 35” or provided by the “requester communication device” is made available to the “service provider” at “computer workstation 14.” *Id.* at Abstract, paras. [0018], [0022], [0024].

The Office asserts that the “network enabled personal computer workstation 14” of FIG. 1 of Parker teaches Applicants’ “second software configured to enable a user at the first home to construct, [at the first home, at least one user defined media channel].” See Office action at page 5. The Office also asserts that the “VT and Record Database Server 35” somehow teaches Applicants’ “at least one user defined media channel.” *Id.* In addition, the Office asserts that the “data network” of Parker teaches Applicants’ claimed “second software” that enables “enable closed and secure communication of the at least one user defined media channel to others within a user defined group that are at separate and distinct locations from the first home, in a peer-to-peer manner, from the first home.” *Id.* Applicants respectfully disagree that Parker teaches what is asserted, and that Parker thereby remedies the admitted failings of Lu and Hoshen. Applicants respectfully submit that Parker is deficient for a number of reasons.

Initially, Applicants respectfully submit that the Office has failed to show where

and how Parker teaches that the “computer workstation 14” is “at a first home,” and therefore fails to show where and how Parker teaches, suggest, or discloses “second software” used for constructing Applicants’ claimed “at least one user-defined media channel” by a “user at a first home,” as required by claim 1. Instead, Parker teaches that the “computer workstation 14” is used by a “medical caregiver” at a “service provider” location. *See* Abstract. Thus, Applicants respectfully submit that Parker fails to teach, suggest, or disclose at least this aspect of Applicants’ claim 1 admittedly missing from Lu and Hoshen.

Further, the Office has not shown where and how Parker teaches, suggests, or discloses “closed and secure communication of the at least one user defined media channel to others (plural) **within a user defined group** that are at separate and distinct locations from the first home, in a peer-to-peer manner, from the first home.” Applicants respectfully submit that Office has failed to show how and why Parker teaches communication of any piece of information to a plurality of recipients from the location of the “service provider,” in accordance with claim 1. Instead, Parker simply teaches that the “data record” corresponding to a “requester” is displayed at the “service provider workstation.” *See id.* at Abstract; Ref. 67 of FIG. 5; paras. [0003], [0008], [0009], [0020], [0025], [0033]. Thus, for at least these reasons, Applicants respectfully submit that Parker fails to teach, suggest, or disclose at least this aspect of Applicants’ claim 1 admittedly missing from Lu and Hoshen.

In addition, Applicants respectfully submit that Applicants’ “at least one user defined media channel” is quite different from the “VT and Data Record Server 35,” which the Office asserted teaches this aspect of claim 1. Applicants’ disclosure

teaches, *inter alia*, that a “media channel” comprises “personal digital media (e.g., captured digital pictures, digital video, digital audio, etc.).” Application at para. [0062]. Applicants respectfully submit that while limitations from the Specification are not to be read into the claims, the claims are to be given their broadest reasonable interpretation, consistent with the Specification. See M.P.E.P. §904.01 and §2145(VI). Applicants respectfully submit that interpretation of Applicants’ “at least one user defined media channel” as a “server” is not consistent with the teachings of Applicants’ Specification. The Office has not shown where and how Parker teaches, suggests, or discloses that the “server 35” comprise “digital media” of the types described by Applicants’ Specification. Thus, for at least these reasons, Applicants respectfully submit that Parker fails to teach, suggest, or disclose at least this aspect of Applicants’ claim 1 admittedly missing from Lu and Hoshen.

If the Office meant to assert that a requester “data record” stored on the “VT and Data Record Server 35” teaches Applicants’ “at least one user-defined media channel,” Applicants respectfully submit that the Office has not shown where and how Parker teaches, suggests, or discloses that the requester “data record” of Parker is “constructed” by the “service provider.” Parker teaches that the “data record” corresponding to a “request” is sent from the “requester communication device” or another location, and that the “service provider” may “update” a “data record” of a “requester.” See, e.g., *id.* at Refs. 63 and 68 of FIG. 5; Ref. 86 of FIG. 6; paras. [0006], [0008], [0009], [0018], [0025], [0026]; [0027], [0030], [0034], and [0036]. In addition, as noted above, the Office fails to show where and how Parker teaches, suggests, or discloses that any “data record” is communicated to “others” (plural) of a “closed and

secure group of users," as required by Applicants' claim 1. Instead, Parker teaches that the "data record" corresponding to a "requester" is merely displayed at the service provider workstation. See *id.* at Abstract; Ref. 67 of FIG. 5; paras. [0003], [0008], [0009], [0020], [0025], [0033]. Thus, for at least these reasons, Applicants respectfully submit that Parker fails to teach, suggest, or disclose at least this aspect of Applicants' claim 1 admittedly missing from Lu and Hoshen.

In addition, Applicants respectfully submit that the Office, by identifying the "personal computer workstation 14" as teaching Applicants' claimed "second software configured to enable a user at the first home to construct, [at the first home, at least one user defined media channel]" is asserting that the "medical caregiver" of the "service provider" corresponds to Applicants' claimed "user." The Office, however, has not shown where and how Parker teaches that the "VT and Data Record Server 35," or any "data record" stored thereon, are defined by the "medical caregiver" of the "service provider", as required by Applicant's claim 1. Instead, Parker simply teaches that the "data record" corresponding to a "requester" is, for example, "one or more computer files" pertaining to the "requester." See paras. [0008], [0018], [0027]. Thus, for at least these reasons, Applicants respectfully submit that Parker fails to teach, suggest, or disclose at least this aspect of Applicants' claim 1 admittedly missing from Lu and Hoshen.

Therefore, for at least the reasons set forth above, Applicants respectfully submit that, contrary to the assertions of the Office, Parker does not remedy the admitted deficiencies of Lu and Hoshen. The Office admits that Lu and Hoshen do not teach, suggest, or disclose, at least, ""second software configured to enable a user at the first

home to construct, at the first home, at least one user defined media channel, the second software also configured to enable closed and secure communication of the at least one user defined media channel to others within a user defined group that are at separate and distinct locations from the first home, in a peer-to-peer manner, from the first home.” Applicants have now demonstrated that Parker also does not teach, suggest, or disclose these features of Applicants’ claim 1. Because the Office admits that Lu and Hoshen do not teach, suggest, or disclose at least these aspects of claim 1, and Applicants have demonstrated that Parker also does not teach, suggest, or disclose at least these aspects of claim 1, it necessarily follows that the proposed combination of Lu, Hoshen and Parker cannot teach, suggest, or disclose at least these aspects of claim 1. Applicants respectfully submit that the Office therefore has not established a *prima facie* case of obviousness, as required by M.P.E.P. §2142 for at least the reasons set forth above. Applicants respectfully submit that the Office has not met the burden of establishing a *prima facie* case of obviousness for at least an additional reason.

Applicants respectfully submit that claim 1 also recites, in part, “software that **maintains a user defined association of the first and second network protocol addresses**, that receives a request that identifies one of the associated first and second network protocol addresses and responds by identifying the other of the associated first and second network protocol addresses **to support delivery via the communication network of the 3rd party media from the at least one server, and the first media from the first storage, to the second home, and the 3rd party media from the at least one server, to the first home, for concurrent consumption of the 3rd party media by the first television, and the 3rd party media and the first media by the**

second television.” Lu does not describe, teach, or suggest these limitations. Instead, as explained previously, Lu merely discloses that a user of a PVR requests delivery of a specific television show, at which point a server computer arbitrarily locates another PVR in a particular broadcast area to record the show for the requesting PVR.

Initially, Applicants respectfully note that it appears that the rejection of this aspect of claim 1 over Lu is simply repeated from the Office action of July 7, 2009, which was addressed in Applicants' response filed December 23, 2009. *See* Office action of July 7, 2009 at pages 5-6. The instant Office action, which repeats the rejection, failed to respond to the substance of Applicants' arguments of December 23, 2009, ignoring the requirements of 37 C.F.R. §1.104 and M.P.E.P. §707.07(f). Indeed, it appears that the Office action of July 7, 2009 also failed to respond to the substance of Applicants arguments of April 15, 2009 in this regard, simply restating the rejection, and arguing, *inter alia*, that “the examiner is forced to interpret the claim limitations as broadly as reasonable possible.” *See* Office action of July 7, 2009 at pages 2-4.

Applicants respectfully submit that an assertion of “broad interpretation” is not a substitute for clearly identifying the most relevant portions of the cited art and providing the “explicit analysis” and “articulated reasoning” required by M.P.E.P. §2142 to demonstrate why one of ordinary skill in the relevant art would come to make the claimed invention. Further, an assertion of “broad interpretation” is not a sufficient response to Applicants' argument, in that the Office has not addressed the substance of Applicants' arguments by explaining how the cited art is being interpreted by the Office, to make the prosecution history complete, as required by M.P.E.P. §707.07(f), and to enable the Applicants, the Board of Patent Appeals and Interferences, and the courts, to

review the reasoning of the Office. **With this in mind, in the event that the Office issues a subsequent rejection of Applicants' claims, Applicants respectfully request that the Office specifically identify by page/paragraph and line, or element and figure the portions of the cited art asserted by the Office as teaching each of the elements of Applicants' claims, and include a detailed explanation of how the identified portions of the cited art being interpreted by the Office to teach what is asserted. A "Response to Arguments" that simply repeats the rejections of the Office action to which the Applicants have responded does not address the substance of Applicants' arguments.**

In the instant rejection, the Office relies only upon Lu and only at col. 6, lines 21-28 and "display 212" of "PVR 200," asserting that these cited portions of Lu alone teach, at least, "the first media from the first storage, to the second home, and the 3rd party media from the at least one server, to the first home, for concurrent consumption of the 3rd party media by the first television, and the 3rd party media and the first media by the second television." The Office does not assert that Hoshen and/or Parker provide any support in regard to rejection of these aspects of claim 1. Applicants respectfully disagree with what Lu is asserted to teach.

A review of Lu shows that "display device 212" appears in FIG. 2, FIG. 3, and FIG. 4, but none of those illustrations of the system of Lu teaches, suggests, or discloses, at least, "the first media from the first storage, to the second home, and the 3rd party media from the at least one server, to the first home, for concurrent consumption of the 3rd party media by the first television, and the 3rd party media and the first media by the second television," contrary to the conclusory statement by the

Office. That is, there is nothing in FIGs. 2, 3, or 4 that teaches anything about consumption of "3rd party media" from a "server" by a television at a "first home," **concurrent** with consumption, by a second television at a "second home," of the "3rd party media" **and** "media from a storage at the first home." **It is simply not there.** Further, the Office fails to provide the "explicit analysis" required by M.P.E.P §2142 to explain how Lu is be interpreted to teach what is asserted. Applicants now turn to Lu at cited col. 6, lines 21-29, which is shown below"

... information and instructions. An optional display device 212 is coupled to bus 210 of personalized video recorder 200 for displaying video and/or graphics. It should be appreciated that optional display device 212 may be a cathode ray tube (CRT), flat panel liquid crystal display (LCD), field emission display (FED), or any other display device suitable for displaying video and/or graphic images and alphanumeric characters recognizable to a user.

Applicants respectfully submit that the portion of Lu shown above fails to make any mention of concurrent consumption of media at first and second homes, let alone that a television at the "first home" consumes media from a "3rd party," while a second television at the second home consumes the media from the "3rd party" **and** media from a storage at the "first home." Instead, the cited portion of Lu, specifically selected by the Office, simply explains that "display device 212" may be "cathode ray tube (CRT), flat panel liquid crystal display (LCD), field emission display (FED), or any other display device suitable for displaying video and/or graphic images and alphanumeric characters recognizable to a user." Thus, the Office has not demonstrated that Lu teaches, suggests, or discloses ""the first media from the first storage, to the second home, and the 3rd party media from the at least one server, to the first home, for concurrent consumption of the 3rd party media by the first television, and the 3rd party media and

the first media by the second television.” Because Lu does not teach, suggest, or disclose at least this aspect of Applicants’ claim 1, and the Office has not even asserted that either Hoshen or Parker teach anything in this regard, Applicants respectfully submit that it necessarily follows that the Office has not shown that the proposed combination of Lu, Hoshen, and Parker teaches, suggests, or discloses at least this aspect of Applicants’ claim 1. Applicants respectfully submit that claim 1 is therefore not rendered unpatentable by the cited art, and is allowable over the cited art for at least these additional reasons set forth above. Applicants respectfully submit that claim 1 is allowable for at least an additional reason.

Applicants respectfully submit that the rejection of claim 1 consists simply of the text of Applicants’ claim 1, interspersed with citations to portions of Lu, Hoshen, and Parker.. For example with respect to the rejection of admitted deficiencies in Lu and Hoshen, the Office simply reproduces Applicants’ claim text, inserts vague references to two elements of FIG. 1 of Parker, adds, verbatim, text that appears in both the Abstract and paragraph [0009] of Parker (without identifying its source), and then concludes with the conclusory statement:

Thus, given the teaching of Parker, it would have been obvious to one of the ordinary skill persons in the art of networking to modify the teaching of Lu-Hoshen into Parker for a software configured user enabled media communication channel within peer network for motivation of efficient deployment of media caregiver or other service provider resources while increasing the quality and information content of communication (see Parker par. 0008).

Applicants respectfully submit that the Office fails to provide the “explicit analysis” and “articulated reasoning,” required by M.P.E.P. §2142, to explain how and why Parker

teaches what is alleged. Applicants respectfully submit that, without explanation by the Office of specifically what in Parker teaches each element of Applicants' claim 1, the assertion by the Office is nothing more than a conclusory statement that "Parker teaches," and Applicants' efforts to reply to the arguments of the Office are made unnecessarily difficult.

Applicants respectfully submit that the M.P.E.P. §2142 is clear that conclusory statements are not sufficient to support a rejection under 35 U.S.C. §103, that the Office **must** provide an "explicit analysis" of why the claimed invention is obvious in view of the cited art. See M.P.E.P. §2142. Applicants respectfully submit that claim 1 is allowable for at least the reason that the Office has not met the requirements of M.P.E.P. §2142 in this regard.

Therefore, should the Office choose to maintain the rejection, Applicants respectfully request that the Office specifically identify the relevant portions of the cited art, down to paragraph/column and line(s) and elements of figures that allegedly teach each and every element of Applicants' claims. For example, with regard to the aspects of claim 1 admittedly missing from Lu and Hoshen, Applicants respectfully request that the Office explain which of the specific teachings of Parker allegedly correspond to Applicants' claimed "user at the first home" and "at least one user defined media channel" and why? What from Parker teaches Applicants' "construct[ion], at the first home" of the "at least one user defined media channel," and why? What from Parker teaches the "others" to whom communication of the "at least one user defined media channel" is made, and why? What in Parker teaches Applicants' "user defined group," and why? What from Parker teaches the

communication of the “at least one user define media channel” to the “others” of a “user defined group,” and why? Applicants respectfully submit that the instant Office action does not answer those questions, which Applicants respectfully submit are part of the “explicit analysis” and “articulated reasoning” required by M.P.E.P. §2142, and that claim 1 is allowable for at least this reason.

With regard to independent claims 15, 25, 30, and 35, Applicants respectfully submit that claims 15, 25, 30, and 35 recite many of the same features and were rejected over the same art for the same reasons set forth in the rejection of claim 1, and that claims 15, 25, 30, and 35 are allowable over the cited art for at least some of the reasons set forth above with respect to the rejection of claim 1.

Therefore, Applicants respectfully submit that the Office has not established a *prima facie* case of obviousness with respect to any of independent claims 1, 15, 25, 30, and 35, as required by M.P.E.P. §2142, that claims 1, 15, 25, 30, and 35 are not rendered unpatentable by the cited art, and that claims 1, 15, 25, 30, and 35, and any claims that depend therefrom are allowable over the proposed combination of Lu, Hoshen, and Parker. Accordingly, Applicants respectfully request that the rejection of claims 1-48 under 35 U.S.C. 103(a) be reconsidered and withdrawn.

Conclusion

In general, the Office Action makes various statements regarding the pending claims and the cited references that are now moot in light of the above. Thus, the Applicants will not address such statements at the present time. The Applicants expressly reserve the right, however, to challenge such statements in the future should the need arise (e.g., if such statement should become relevant by appearing in a future claim rejection).

The Applicants respectfully submit that the Office Action has not established a *prima facie* case of anticipation or obviousness with respect to any of the pending claims for at least the reasons discussed above and request that the outstanding rejections be reconsidered and withdrawn. If the Examiner has any questions or the Applicants can be of any assistance, the Examiner is invited to contact the undersigned attorney for Applicants.

The Commissioner is authorized to charge any fees required by this submission, or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Account No. 13-0017.

Respectfully submitted,

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